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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/752,065
Filing Date: December 29, 2000
Appellant(s): ALBERTI ET AL.

David A. Pascarella, Reg. No. 36,632
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 May 2006 appealing from the

Office action mailed 14 July 2004.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,794,207   WALKER et al.   8-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74 and 76 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Walker et al., U.S. Patent No. 5,794,207.

As per claims 1-8, 10-23, 25-33, 35-48, 50-60, 62-74 and 76, Walker et al. teach a method for managing information comprising:

- identifying information (e.g. entered data regarding proposal for a contract) to be managed (figure 1)

- managing information within a public environment offline from the private environment (figures 2, 6 and 20; column 12, lines 8-21 and 40-53; column 14, lines 33-39; column/line 22/39-23/19; column 27, lines 20-43)

- obtaining (e.g. pre-fetching) data from the private electronic environment to be used for creating the proposal and wherein the private environment comprises executing a server running an enterprise resource planning system (figures 6 and 14; column 12, lines 40-53; column/line 16/62-17/8; column 24/24-25/19; column/line 27/30-30/29)

- negotiating one or more terms of the proposal while disconnected from the private environment (column/line 15/45-16/63; column 19, lines 54-60; column/line 22/39-23/19)

- managing in said public environment comprising maintaining (or storing), obtaining status related to information and a report related to the information (figures 2, 6 and 20; column 12, lines 8-21 and 40-53; column/line 16/62-17/8; column 17, lines 25-47; column/line 22/39-23/19; column 27/20-28/18)

- registering (in real-time) the information with the private environment (figures 2, 5 and 6; column 12, lines 8-21 and 40-53)

- requesting approval of the information wherein registering is in response to the approval (figures 5 and 6; column/lines 16/62-17/8; column 17, lines 25-47; column/line 23/65-25/35; column 27/20-28/18)

- registering a proposal to form a contract and administering a contract (abstract; column 8, lines 27-56)

- a public environment comprising a web server executing a portal (figures 1 and 2; column 14, lines 8-30)

Walker et al. also teach:

- obtaining proposal data from a private environment, creating the proposal in a public environment and providing said proposal to

said private environment, approving said proposal prior to providing

said proposal to the private environment, registering the proposal

with a private electronic environment, wherein the approved

proposal becomes a [sales] contract, negotiating one or more terms

of the proposal (abstract; column/line 22/39-23/19; column/line

23/65-25/35; column 26, lines 47-56)

- public environment comprises a web server (figures 1 and 2;

  column 14, lines 8-30)

Claim Rejections - 35 USC § 103

Claims 24, 49 and 75 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Walker et al., U.S. Patent No. 5,794,207.

As per claim 24, 49 and 75, Walker et al. teach a system for managing

information utilizing a distributed processing architecture (figures 1, 2 and 20;

column 12, lines 8-20 and 35-53; column 14, lines 30-40; column/line 27/20-

28/18). Walker et al. do not explicitly recite firewalls, however, firewalls are well

known systems used for protecting a network from an external threat. Therefore,

it would have been obvious to one of ordinary skill to utilize a firewall to protect a

computing environment from unauthorized accesses to private data (user identity

data, credit card data, transaction data... etc.)

(10) Response to Argument

102 Rejection

Appellant is of the opinion that the system of Walker et al. is not valid art because, for example, it is directed to buyer-driven e-commerce (Appeal Brief, pages 6 and 7). However, it has been held that the question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims (*State Contracting & Eng' g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003)). Therefore, Appellant's contention that the prior art of Walker et al. is inappropriate in terms of art is moot as Walker et al. clearly anticipates Appellant's claimed method, system and apparatus.

Claims 1-8, 10-18, 26-33, 35-39, 41-43, 51, 53-60 and 62-70, and 19-25, 44-50, 52, and 71-76

Identifying information, via a public electronic environment, from an enterprise resource planning system within a private electronic environment

The Examiner interprets the above limitation as identifying information from an

enterprise resource planning system within a private electronic environment, via a public

network. In other words, a user identifies information using a public electronic network,

wherein the information is stored in an ERP system within a private electronic

environment.

Walker et al. teach a seller browsing CPOs with an intent to bind ('207,

column/line 23/64-24/23; column 29, lines 5-10) at a web page over the internet ('207,

column 9, lines 5-16; column 18, lines 17-32). Therefore, Walker et al. teach "identifying

information via a public electronic environment". The central controller that displays the

web page is an enterprise resource planning system ('207, figure 2). Appellant defines

an "ERP" system as an integrated transaction-processing system that handles an

organization's information (Remarks, dated 3-26-2004, page 13, fourth full paragraph,

"For example, an enterprise resource planning (ERP) system is..."). Therefore, the

central controller of Walker et al. ('207, figures 2 and 20) according to Appellant's

definition is an ERP system because it houses the buyer and seller registration and

authentication, message exchange, payment and website (e.g. for displaying CPOs)

applications ('207, figure 2; column/line 8/42-10/30) (i.e. integrated transaction

processing) for creating the CPO marketplace and manages and stores all of the

marketplace's information (i.e. handles an organization's information) such as contracts

(CPO database, contract detail database- '207, figure 2). Further, the information, such

as CPOs and responses, is maintained within a private electronic environment because

buyers and sellers can only access limited information stored at the central controller

('207, figure 2) and/or only certified (i.e. authenticated cryptographically or otherwise)

sellers can browse and bind the CPOs ('207, column/line 23/64-24/23; column 29, lines

5-16). Note, the central controller is also private because it maintains cryptographic

keys ('207, column 13, lines 54-60).

Managing the information using the public electronic environment, wherein one or

more aspects of managing the information are performed within the public electronic

environment off-line from the private electronic environment

Walker et al. teach buyers and sellers exchanging responses (counteroffers,

proposals, etc.) over a public network ('207, column 9, lines 44-51; column 15, lines 40-

44; column 19, lines 55-60; column 22, lines 40-51). Therefore, Walker et al. teach

"managing the information using the public environment". Walker et al. specifically recite

that messages can be transmitted directly between buyer and seller ('207, column 19,

lines 55-60). Hence, Walker et al. also teach aspects of managing (i.e. response and

counteroffer exchanges between buyer and seller) off-line or disconnected from the

private electronic environment (e.g. encryption, authentication, verification) of the

central controller.

Registering the managed information, via the public electronic environment, with

the private electronic environment

While Walker et al. disclose buyers and sellers exchanging responses directly

('207, column 19, lines 55-60), Walker et al. also teaches the central controller receiving

responses such as counteroffers ('207, column/line 22/65-23/5). Therefore, managed

information, such as counteroffers, is registered within the private environment, as it is

verified for authenticity using cryptography such that only messages from the seller in

possession of the appropriate key can have her/his counteroffer stored by the central

controller ('207, column 13, lines 54-60; column 19, lines 45-60; column/line 22/65-23/5;

column 24, lines 47-64).

Further, one of ordinary skill would recognize the central controller as "private" as

it is owned by a company, entity or person(s) ('207, column 20, lines 16-30).

Appellant is of the opinion that the prior art does not teach registration of a

completed agreed upon new contract (Appeal Brief, page 10, fourth full paragraph),

"Fourth, registration..."), however the claims are silent such a limitation and although

the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.

Cir. 1993)). Nonetheless, Walker et al. teach the central controller receiving responses

and counteroffers, and stores the ultimately agreed upon contract ('207, column 13,

lines 22-34; column 19, lines 45-60; column/line 22/65-23/5).

Claims 17, 42, and 69

Appellant is of the opinion that the prior art of Walker et al. does not teach "pre-

fetching data" because the central controller does not fetch any information from the

buyer and seller (Appeal Brief, page 13, fourth full paragraph, "In addition..."). Similarly,

Appellant attempts to further describe "pre-fetching" by defining the act as when "a

server in the public electronic environment accesses data from an ERP system in the

private electronic environment and selects specific information that is needed, for

example, as a base for the contract" (Appeal Brief, page 13, fourth full paragraph, "In

addition...", lines 3-6). However, the claim 1, from which claim 17 depends, for example,

is silent this specificity and although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims (*In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Nonetheless, Walker et al.

teach retrieving a symmetric or public key from a cryptographic key database for

encrypting and decrypting (i.e. authenticating) CPOs, seller responses and

counteroffers ('207, figure 2; column 13, lines 54-58; column 24, lines 23-64;

column/line 24/64-25/29), in other words the keys are stored and accessible prior to

actual use (i.e. pre-fetched). Therefore the prior art teaches pre-fetching data from said

private electronic environment to be used in the managing of said information as is

recited in claim 17.

Claims 10, 12, 35, 46, 62, and 73

Claim 10 recites "wherein said managing comprises requesting approval of the

information, and wherein said registering is performed in response to the approval". This

limitation is explicitly taught by the prior art as Walker et al. teach buyers requesting

authentication and verification of seller responses and counteroffers ('207, column 19,

lines 45-60; column 24, lines 23-64).
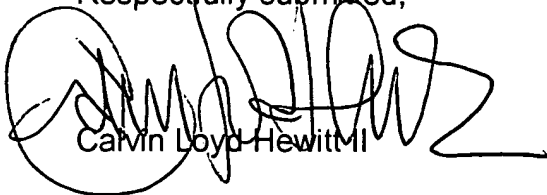
103 Rejection

Claims 24, 49, and 75

Firewalls are old and well known. Microsoft Press Computer Dictionary Third

Edition defines "firewall" as a "security system intended to protect an organization's

network against external threats, such as hackers, coming another network, such as the

internet." The central controller of Walker et al. ('207, figure 2) comprises a network

interface for connecting to the internet ('207, column 14, lines 8-30). The central

controller also stores cryptographic keys ('207, figure 2), wherein the keys are used to

verify and authenticate messages exchanged between buyers and sellers ('207, column

13, lines 53-58; column 19, lines 55-60; column 24, lines 23-64). Hence, it would have

been obvious to one of ordinary skill in network security to use a firewall to protect the

central controller and prevent malicious users from obtaining keys and placing

fraudulent response and counteroffer messages ('207, column 24, lines 46-64)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Calvin Loyd Hewitt II

Conferees:

Kambiz Abdi

Hyung Sough